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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,776	07/17/2003	John Randall Fredlund	67244IF-P	1680
7590	10/05/2005		EXAMINER LEE, CHEUKFAN	
Milton S. Sales Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/621,776	Applicant(s) FREDLUND ET AL.	
	Examiner Cheukfan Lee	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 14 and 16-28 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/2004, 4/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-28 are pending. Claims 1 and 14 are independent.

2. Claims 14-28 are objected to because of the following:

In claim 14, line 7 of the claim, "is used" should be changed to – being used --.

In claims 25 and 26, "said order number" lacks antecedent basis.

In claim 25, line 3, "is" should be changed to – are --.

In claim 26, lines 2-3, "said index print" lacks antecedent basis. Claim 26 should depend on claim 25, not claim 14.

Claims 15-28 are objected to as being dependent on an objected base claim.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 14 and 16-28, insofar as claim 26 is understood to depend on claim 25 (as opposed to claim 14), are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 of U.S.

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Patent No. 6,600,572. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason given below.

Claim 14 recites a system corresponding to the method of patent claim 1, except that patent claim 1 additionally recites "ordering ... by a plurality of customers" and uses terminology "an associated number" instead of order number of patent claim 1 and terminology "mass storage device" instead of "a memory" of patent claim 1, and uses terminology "a computer having a mass storage device", and except that claim 14 does not recite delivery of the image product.

With respect to a plurality of customers, since patent claim 1 provides for remotely ordering image products or services (preamble), one of ordinary skill in the art would have realized that the product or services with respect to the digitally stored image are intended for more or one customers to place an order(s). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a plurality of customers so more than one customer place order for the image product or services.

With respect to the use of terminology "an associated number", claim 14 claims that the number is used for identifying the images and for ordering products or services, and patent claim 1 claims associating an order number that identifies the digital file. These languages of claim 14 and patent claim 1 mean virtually the same thing.

With respect to the computer having the mass storage device, since patent claim 1 provides digitally stored images for ordering, one of ordinary skill in the art would have realized that the digitally stored images for ordering requires that the memory device be

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a device of relatively large capacity, and thus, the memory device of patent claim 1 is considered a mass storage. Further, with the method of patent claim 1, one of ordinary skill in the art would have realized the advantage of managing the memory having the digital file(s) in a computer, which is the convenience provided by the computer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide patent claim 1 with a computer for managing the digital files for ordering by customers including facilitating the remote electronic order of an image product or a service.

With respect to the limitation of patent claim 1 that is not in claim 14, In re Karlson states: It is well settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. In re Nelson, 40 CCPA 708, 198 F.2d 837, 95 USPQ 82; In re Eliot, 22 CCPA 1088, 76 F.2d 309, 25 USPQ 111.

In the instant case, with the omission of "delivering the image product" in patent claim 1, the rest of the claim functions the same as before. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the delivering the image product.

Claim 16 claims the limitation of patent claim 2.

Claims 17-28 claim the limitations of claims 3-12, 14, and 13, respectively.

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5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 1-13 are allowed.

7. The following is an examiner's statement of reasons for allowance:

Claims 1-13 are allowable because there is no double patenting of either the same type or the obviousness type between the claims and any of the claims of patent U.S. Patent No. 6,600,572. Specifically, the limitation recited in claim 1, "facilitating the destination of a party by said customer to which said image product or service is to be provided", is not claimed in any of the claims of the patent.

Claim 15 would be allowable for the reason that claim 15 recites a limitation similar to that of claim 1 discussed above in the reason for allowance.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
September 26, 2005



Cheukfan Lee